

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: 9/5/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Factory 79, Inc.

Serial No. 78366331

Jeffrey Landes of Catalyst Law Group, APC for Factory 79, Inc.

Carrie Achen, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Bucher and Grendel, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Factory 79, Inc. to register the mark GENESIS for "precious stones and jewelry of precious metals."¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, as applied to applicant's goods, so resembles the previously registered

¹ Application Serial No. 78366331, filed February 11, 2004, alleging first use anywhere and first use in commerce on July 1, 1994.

Ser No. 78366331

mark GENESIS for "watches and clocks"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant contends that the marks are different in that "applicant uses the mark on goods comprising Christian emblems and sayings, thus leaving a general impression on the consumer that Applicant's goods are Christian in nature; whereas Registrant does not." (Appeal Brief, p. 3). Applicant also argues that the goods are not related or marketed in a way that makes confusion likely to occur among consumers and, in this connection, applicant states that there has not been any actual confusion despite eleven years of contemporaneous use with registrant's mark. Applicant also argues that the prior existence of a third-party registration, now canceled, buttresses its view of no likelihood of confusion. More specifically, applicant points to canceled Registration No. 2079501 for the mark GENESIS for precious stones and jewelry of precious metals. Applicant asserts that inasmuch as this third-party registration (for a mark and goods identical to applicant's mark and goods) issued over registrant's registration cited

² Registration No. 1498555, issued August 2, 1988; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

herein, the coexistence of the registrations on the register shows that applicant's mark should now be allowed to coexist on the register with the cited registration.

The examining attorney maintains that the marks are identical and that the goods are closely related. In connection with the goods, the examining attorney submitted several third-party used-based registrations showing that the same entity adopted the same mark for jewelry, watches and clocks. The examining attorney also submitted catalog excerpts from online retail store websites showing that jewelry, watches and clocks are sold in the same trade channels by the same source.

Before focusing on the substantive refusal, we direct our attention to an evidentiary matter. Applicant submitted, for the first time with its appeal brief, a declaration of applicant's president, a printout listing third-party registrations retrieved via a search of the USPTO's TESS database, and dictionary definitions found in online dictionaries. The examining attorney, in her brief, objected to the untimely submission of this evidence, citing to Trademark Rule 2.142(d).

The examining attorney is correct in stating that the record in the application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d). Additional

Ser No. 78366331

evidence filed after appeal normally will be given no consideration by the Board. Thus, we decline to consider the declaration of April Fisher, applicant's president, who attests that she is unaware of any instances of actual confusion. We hasten to add, however, that even if considered, the evidence would not compel a different result on the merits in this appeal. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); and *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27. In any event, it is unnecessary to show actual confusion in establishing a likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

We likewise will not consider, due to its late submission, the printout of the list of third-party registrations retrieved from the USPTO's TESS database. Further with respect to the TESS printout, and in any event, the mere submission of a listing from the TESS database is insufficient to make the referenced registrations of record. To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted. In *re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456

Ser No. 78366331

n. 2 (TTAB 1998). We should add that, even if considered, the list would not compel a different result in this case. The list does not show the goods covered by the registrations. Therefore, it has extremely limited probative value, since we cannot determine whether the marks are for goods similar to those of applicant and registrant. See TBMP § 1208.02 (2d ed. rev. 2004). In this connection, even complete copies of third-party registrations covering goods far removed from the goods of applicant and registrant would be irrelevant to the present likelihood of confusion analysis. See *Conde Nast Publications, Inc. v. American Greetings Corp.*, 329 F.2d 1012, 141 USPQ 249, 252 (CCPA 1964).

Also submitted late were two dictionary definitions retrieved from Merriam-Webster Online (www.m-w.com). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). However, the Board will not take judicial notice of definitions found only in online dictionaries and not available in printed format. In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). In the present case, inasmuch as Merriam-Webster dictionaries are available in printed

format, we have opted to take judicial notice of the dictionary definitions of "Genesis" and "genesis."

We now turn to the substantive issue on appeal. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1203-04. In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the marks, they are identical in every respect. That is to say, applicant's and registrant's GENESIS marks are identical in sound, appearance, meaning and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Use of identical marks is a fact that "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ

1289, 1290 (Fed. Cir. 1984); see also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

Although applicant concedes the identity between the marks in sound and appearance, it goes on to argue that the marks have different meanings. In considering the marks, we note that the term "Genesis" (with an upper case "G") is defined as "the mainly narrative first book of canonical Jewish and Christian Scriptures" while the term "genesis" (with a lower case "g") is defined as "the origin or coming into being of something." Applicant states that its goods are Christian jewelry, that is, that the goods themselves comprise Christian sayings, ideas and symbols; and that its goods are marketed to consumers who are interested in wearing jewelry bearing these Christian sayings, ideas and symbols. Thus, applicant contends, the meaning of its mark "GENESIS," as used in connection with applicant's goods, is Christian, drawing a connection with the Christian Bible, whereas there is no indication that registrant's mark connotes the Christian meaning of the word.

Any difference in meaning is clearly outweighed by the identity in sound, appearance and commercial impression. Further, inasmuch as the cited mark is registered in typed (or standard character) form, registrant is free to use its mark with an upper case "G." In addition, inasmuch as

registrant's identification of goods does not include any limitations, the identification is broad enough to encompass watches and clocks with a Christian theme; in such circumstances the use of "GENESIS" (with an upper case "G") would convey the same meaning as the one applicant asserts its mark conveys. In a similar vein, applicant's identification is not restricted to Christian jewelry;³ thus, the use of GENESIS on jewelry lacking a "Christian theme" may not convey the biblical meaning.

We next turn to a consideration of the goods. We note, at the outset of considering this du Pont factor, that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's goods and registrant's goods that is required to support a finding of likelihood of confusion. In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are the same, as in this case, it is only necessary that there be a viable

³ Applicant asserts that, during a telephone conversation with the examining attorney, it offered to amend its identification of goods to limit its jewelry to "Christian jewelry." According to applicant, it "called the Examiner and unsuccessfully proffered an amendment that further limited and defined the application of goods by inserting the word 'Christian' before the word 'jewelry.'" (Appeal Brief, p. 2). In the absence of such amendment, we must presume that applicant's identification of goods encompasses jewelry of all nature and types. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

relationship between the goods in order to support a finding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

In the past, the Board has found that jewelry and watches are related goods. See *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506 (TTAB 1972); and *Gruen Industries, Inc. v. Ray Curran & Co.*, 152 USPQ 778 (TTAB 1967). In connection with the argument that the goods are commercially related, the examining attorney submitted several third-party registrations, based on use in commerce, covering jewelry, watches and clocks. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. In re *Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

The examining attorney also submitted excerpts from the catalogs of six online retailers. This evidence shows that jewelry, watches and clocks are sold in the same trade channels and are marketed to the same classes of purchasers. These purchasers include ordinary consumers who may exercise nothing more than ordinary care when

purchasing such goods when they are sold at relatively inexpensive prices.

We find that jewelry, watches and clocks are sufficiently related that, when sold under identical marks, confusion is likely to occur among purchasers in the marketplace.

As referenced above, applicant cites to an expired third-party registration for a mark and goods identical to the mark and goods set forth in the involved application. Applicant contends that this evidence shows "that the market recognizes Applicant's goods as sufficiently unrelated to registrant's goods and is not confused when these dissimilar goods bear the same mark." (Reply Brief, p. 2). Applicant further points out that this earlier registration issued over registrant's registration, and that registrant neither filed an opposition against the underlying application nor a petition to cancel against the registration.

In making this argument, applicant readily acknowledges that the Board is not bound by the prior actions of examining attorneys. Indeed, there is longstanding, well-settled precedent holding that the Board is not bound by prior decisions of examining attorneys, and that each case must be decided on its own merits and on the

basis of its own record, in accordance with relevant statutory, regulatory and decisional authority. See, e.g., *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999). More specifically, we are not bound by the previous examining attorney's determination that the third-party's mark was registrable, and we will not compound the problem of the registration of a confusingly similar mark by permitting registration, this time to applicant, of the identical mark for the same goods, again. See *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

The fact that the cited mark and the third-party's mark at one time coexisted on the register does not prove that they coexisted during that time without confusion in the marketplace. Without evidence of the nature and extent of both the third-party's and registrant's use of their respective marks, we cannot determine whether a meaningful opportunity for actual confusion ever existed. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). We cannot conclude that registrant had no objection to the third-party's earlier registration simply because registrant failed to object to it. We are not privy to registrant's reasons for not challenging the registration

Ser No. 78366331

and we will not speculate about them. Further, any objections registrant may have had to the earlier registration were eliminated once the registration was canceled. In re Thomas, 79 USPQ2d at 1028. See Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ["[A] canceled registration does not provide constructive notice of anything."].

We conclude that consumers familiar with registrant's watches and clocks sold under its mark GENESIS would be likely to believe, upon encountering applicant's precious stones and jewelry of precious metal sold under the identical mark GENESIS, that the goods originate with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register is affirmed.